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BRG BRILLIANT RUBBER GOODS (M) SDN BHD v. LEONG CHOON LOY TRADING AS HILLWAY TRADING; THE REGISTRAR OF TRADE MARKS, MALAYSIA (INTERESTED PARTY)

HIGH COURT MALAYA, KUALA LUMPUR

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AZIZAH NAWAWI J

[ORIGINATING SUMMONS NO: 24IP-2-01-2015]

24 NOVEMBER 2015

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INTELLECTUAL PROPERTY: *Trade marks – Registration of trade mark – Plaintiff opposed Registrar's decision in allowing registration of defendant's ROYAL POLO mark – Whether marks confusingly and deceptively similar to plaintiff's POLO trade mark – Whether marks were visually, conceptually and phonetically different – Whether word 'Royal' made defendant's mark different from plaintiff's registered mark – Whether plaintiff could seek to claim monopoly over generic and non-distinctive word 'Polo' – Whether defendant's filing of trade mark bona fide –*

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Whether defendant's mark distinguishable from plaintiff's – Whether public would be deceived that goods bearing defendant's Royal Polo mark could be associated with plaintiff's Polo marks – Trade Marks Act 1976, ss. 14(1), 19(1), 82(2)

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This was an appeal filed by the plaintiff against the decision of the Registrar in allowing the registration of the 'Royal Polo' mark. The plaintiff, a company incorporated in Malaysia, had been manufacturing and selling a wide range of goods under the Polo marks in Malaysia and had obtained registration for its Polo marks. The plaintiff was the opponent before the Registrar in the opposition proceedings wherein the plaintiff had opposed the

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defendant's trade mark application for registration of the mark 'Royal Polo' (the defendant's mark) in Class 18 on, *inter alia*, the ground that the offending mark was confusingly and deceptively similar to the plaintiff's family of trademarks, namely 'Polo', 'POLO' and 'Polo Haus' or marks containing the word 'polo' or 'POLO' with or without the 'Polo player device' or 'Horse device' ('the Polo marks'). The Registrar dismissed the plaintiff's opposition.

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Hence, this appeal. The plaintiff's grounds of appeal were that: (i) the Registrar failed to find that the defendant's marks were confusingly/ deceptively similar to the plaintiff's POLO marks and offended ss. 14 and 19 of the Trade Marks Act 1976 ('TMA'); (ii) the Registrar erred in law in holding that the word 'polo' *per se* was not inherently distinctive merely

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because it was an ordinary English word; (iii) the Registrar erred in law and in fact in relying on the presence of other trademarks which had the word 'polo' as part of the mark on the Register of Trade Marks; (iv) the Registrar failed to find that the defendant was not the *bona fide* proprietor of the Marks under s. 25(1) of the TMA; (v) the Registrar failed to consider that the

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plaintiff had acquired goodwill and reputation in its business in relation to the POLO marks; (vi) the Registrar failed to find that the defendant failed to establish the distinctiveness of its Marks under s. 10 of the TMA; and

(vii) the Registrar had erred in law and in fact in failing to hold that the registration or use of the defendant's mark by the defendant would constitute passing off in common law and contrary to s. 82(2) of the TMA.

Held (dismissing plaintiff's appeal):

(1) Having considered the plaintiff's registered mark POLO and the defendant's ROYAL POLO mark, there was no similarity between the two marks. Visually, conceptually or phonetically, the two marks were clearly different. The defendant's mark was not similar or identical to the plaintiff's registered mark. The word 'ROYAL' made the defendant's marks totally different from the plaintiff's registered marks. Therefore, the use of the defendant's trade mark would not result in confusion and deception in a manner which would offend s. 19(1) of the TMA. (paras 20-22)

(2) The word 'polo' cannot be simply selected in the defendant's trademark and be compared with the word 'polo' in the plaintiff's mark, and completely ignore the word 'Royal.' The plaintiff had also not complied with the basic principles of comparisons of marks. The plaintiff had effectively dissected the word 'Royal' from the defendant's Royal Polo Mark in order to make the comparison. The plaintiff did not apply the *Pianotist* test as adopted in *Tohtonku*'s case that when comparing marks, the marks must be viewed as a whole. Therefore, even if there was a common element in the word 'polo', the use of the words 'Royal' by the defendant on its mark would not cause any likelihood of confusion. Thus the Registrar was correct to dismiss the plaintiff's opposition to the registration of the defendant's marks. (paras 30, 32 & 38)

(3) The existence of many other polo related marks on the Register showed that the polo marks were common in this country. The plaintiff therefore could not claim monopoly over the said mark. To allow the plaintiff's appeal would effectively give the plaintiff a monopoly over the generic and non-distinctive word 'polo.' There was further no likelihood of confusion between the defendant's Royal Polo Mark and the plaintiff's 'polo' marks. (paras 40, 42 & 46)

(4) The *bona fide* of the defendant in filing its trade mark could not be doubted as the defendant had been using the Royal Polo mark since 2003, as seen from the sales figure. The defendant could not be said to be adopting the plaintiff's Polo trade mark, as they were totally different marks. The defendant was seeking to register its own trade mark, Royal Polo, which was different from the plaintiff's trade mark. (paras 50 & 54)

(5) Since the plaintiff's marks were different from the defendant's Royal Polo mark, the issue of the plaintiff's goodwill and reputation in its business relating to the 'Polo' marks was not relevant. The two marks were clearly distinguishable that members of the trade and the public

would not assume or be deceived that the goods bearing the defendant's Royal Polo mark could in any way be associated with the plaintiff's polo marks. (paras 58 & 59)

(6) The defendant's mark was not confusingly similar to the plaintiff's POLO marks; thus the issue of passing off was not relevant. In any event, the Registrar had no jurisdiction on issues of passing off. Whether there was a case that would constitute passing off was for the court to decide, and the plaintiff ought to commence its case for passing off in the High Court (s. 82(2) of the TMA). (para 62)

(7) For the Polo Mark, the plaintiff had not adduced any evidence to show actual use since the date of registration in 1981, as the invoices merely referred to polo shirts and pants. There was no actual use in respect of goods in Class 18. The defendant was using its own mark Royal Polo which was distinctive of the defendant. The defendant's mark was visually and phonetically different from the plaintiff's POLO marks. As such, there could be no actual or likelihood of confusion or deception. (paras 63 & 64)

Case(s) referred to:

10 Royal Berkshire Polo Club Trade Mark (2001) RPC 643 ***(refd)***
Club Europe Trade Mark (2000) RPC 329 ***(refd)***
Coca Cola of Canada v. Pepsi Cola of Canada (1942) 59 RPC 127 ***(refd)***
Corn Products Refining Co v. Shangrila Food Products Ltd AIR 1960 SC 142 ***(refd)***
Eriktico v. Erector [1935] 52 RPC 136 ***(refd)***
Harrods Application (1935) 52 RPC 65 ***(refd)***
Helena Rubinstein Ltd's Appln (1960) ROC 229 ***(refd)***
In the Matter of the Trade Marks Act, 1983 and in the matter of Vitamin's Ld' Application [1956] RPC 1 ***(dist)***
McCain International Ltd v. Country Fair Foods Limited And Another (1981) 5 RPC 69 ***(refd)***
Polo/Lauren Co LP v. United States Polo Association [2002] 1 SLR 326 ***(refd)***
The Commissioner of Inland Revenue v. Muller & Co's Margarine Ltd [1901] AC 217 ***(refd)***
The Polo/Lauren Co LP v. Shop In Department Stores Pte Ltd [2006] 2 SLR 690 CA ***(refd)***
Tohtonku Sdn Bhd v. Superace (M) Sdn Bhd [1992] 2 CLJ 1153; [1992] 1 CLJ (Rep) 344 SC ***(refd)***
Walton International Ltd v. Yong Teng Hin; Pendaftar Cap Dagangan, Malaysia (Interested Party) [2010] 8 CLJ 802 CA ***(dist)***
Willesden Varnish Company Ld v. Young & Marten Ld (1922) 39 RPC 285 ***(refd)***
Yong Teng Hing b/s Hong Kong Trading Co & Anor v. Walton International Ltd [2012] 6 CLJ 337 FC ***(refd)***

Legislation referred to:

Trade Marks Act 1976, ss. 10, 14(1)(a), 19(1), 25(1), 67, 82(2)

English Trade Marks Act 1938 [UK], s. 17(1)

For the plaintiff - Wendy Lee; M/s Shook Lin & Bok
For the defendant - PC Kok; M/s PC Kok & Co (for M/s Mohd Rawi, Andrew & Assocs)

Reported by Suhainah Wahiduddin

JUDGMENT

Azizah Nawawi J:

Appeal

[1] This is an appeal filed by the plaintiff against the decision of the learned Registrar dated 10 December 2014 which allowed the registration of the 폴로 랄프 로렌 mark in Class 18 which is the subject matter of Trade Mark Application No. 08003587. Goods included in Class 18 are "leather and imitation of leather and goods made of these materials and not included in other classes, handbags, luggage bags, suitcases, briefcases, key cases and trunks".

[2] After hearing the parties, this court had dismissed the plaintiff's appeal.

The Salient Facts

[3] The plaintiff is a company incorporated in Malaysia. It has, by itself or its licensees, been manufacturing and selling a wide range of goods under the Polo marks in Malaysia and had obtained registration for its Polo marks, namely the Polo mark, in Classes 25 and 28 in Malaysia on 28 August 1981:

Trademark No.	Mark	Class
M/091943	Polo	28
M/091944	Polo	25

[4] The plaintiff is the opponent before the learned Registrar in opposition proceedings wherein the plaintiff had opposed the defendant's Trade Mark Application No. 08003587 for registration of the mark "폴로 랄프 로렌" ("defendant's mark") in Class 18 on, *inter alia*, the ground that the offending mark is confusingly and deceptively similar to the plaintiff's family of trademarks, namely "Polo", "POLO", "Polo Haus", "Polo player device", "Horse device" and/or marks containing the word "Polo" and/or "POLO" with or without the "Polo player device" or "Horse device" ("the POLO marks"). Some of the POLO marks are as follows:

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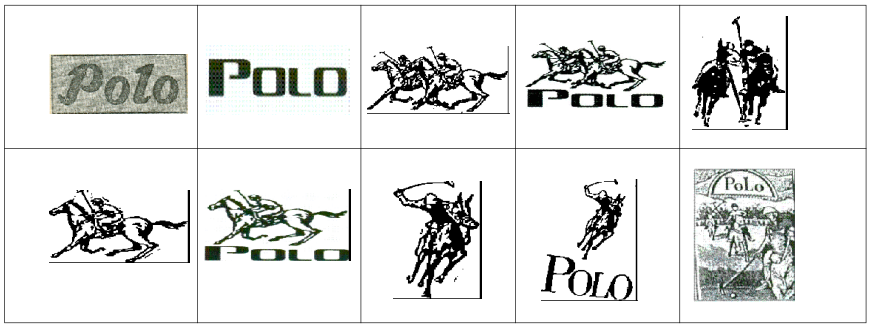

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[5] The defendant applied to register the ROYAL POLO on 26 February 2008 in Class 18. The application was published in the Government Gazette on 30 September 2010. The plaintiff had opposed the defendant's application *vide* a notice of opposition dated 29 November 2010.

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[6] The opposition proceeded before the Registrar who had dismissed the plaintiff's opposition on 10 December 2014. Being dissatisfied with the Registrar's decision, the plaintiff files this appeal.

The Findings Of The Court

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[7] It is common ground that under s. 67 of the Trade Marks Act 1976 ('TMA 1976'), this court has the power to review, reverse or otherwise vary the decisions of the learned Registrar.

[8] It is also common ground that the burden of proof is on the defendant, as the applicant for registration of the defendant's ROYAL POLO mark, to satisfy

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the Registrar and this court that the said mark is registrable under the TMA 1976. In *Yong Teng Hing b/s Hong Kong Trading Co & Anor v Walton International Ltd* [2012] 6 CLJ 337 FC, Justice Zulkefli Makinudin CJ (Malaya) held at p. 348 as follows:

> [12] It is to be noted in the present case, the respondent filed its notice of opposition before the appellant's mark could be registered. On this point it is our judgment that the onus is on the appellant to prove that he is entitled to register the "GIORDANO" trade mark.

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[9] The plaintiff's grounds of appeal are as follows:

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(i) that the Registrar failed to find that the defendant's marks are confusingly/deceptively similar to the plaintiff's POLO marks and offends of ss. 14 and 19 of the TMA 1976;

(ii) that the Registrar erred in law in holding that the word "polo" *per se* is not inherently distinctive merely because it is an ordinary English word;

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(iii) that the Registrar erred in law and/or in fact in relying on the presence of other trademarks which has the word 'polo' as part of the mark on the Register of Trade Marks;

(iv) that the Registrar failed to find that the defendant is not the *bona fide* proprietor of the marks under s. 25(1) of the TMA 1976;

(v) that the Registrar failed to consider that the plaintiff has acquired goodwill and reputation in its business in relation to the POLO marks and that the POLO marks;

(vi) that the Registrar failed to find that the defendant failed to establish the distinctiveness of its marks under s. 10 of the TMA 1976;

(vii) that the Registrar has erred in law and/or facts in failing to hold that the registration and/or use of the defendant's mark by the defendant would constitute passing off in common law, contrary to s. 82(2) of the TMA 1976.

Issues (i), (ii) And (iii)

[10] The plaintiff's main ground for opposing the registration of the defendant's mark is that the defendant's mark is confusingly and/or deceptively similar to the plaintiff's POLO marks. The plaintiff states that it has, by itself or through its licensees, been using the POLO marks in relation to its goods in Malaysia long before the date of application of the defendant's mark, since the year 1981 when the plaintiff's mark was registered.

[11] The plaintiff also submit that it is clear from the evidence adduced by the plaintiff in the opposition proceedings before the Registrar that there has been extensive use and promotion of the POLO marks by the plaintiff and its licensees which consequently shows that the POLO marks have become distinctive of the plaintiff and its goods in Malaysia.

[12] Therefore, the defendant's mark ought not to be allowed to proceed to registration as the defendant's mark is not entitled to registration under s. 14(1)(a) and s. 19 of the Trade Marks Act 1976 ('TMA 1976') by reason of its confusing and/or deceptive similarity to the POLO marks.

[13] In determining whether the defendant's mark is confusingly similar to the plaintiff's mark, the relevant test can be found in the Supreme Court decision of *Tohtonku Sdn Bhd v. Superace (M) Sdn Bhd* [1992] 2 CLJ 1153; [1992] 1 CLJ (Rep) 344; [1992] 2 MLJ 63, where the court held that:

> The 'test' which Wan Adnan J was referring to were contained in Parker J's judgment in The Pianotist Co Ltd in the following terms:
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> > You must take two words. You must judge them, both by their look and by their sound. You must consider the goods to which they are to be applied. You must consider the nature and kind of customer who would be likely to buy those goods. In fact you must consider all the surrounding circumstances; and you must further consider what is likely to happen if each of those trademarks is used in a normal way as a trade mark for the goods of the respective owners of the marks.

[14] The test formulated by the court in the *Pianotist* case, as accepted by our Supreme Court in *Tohtonku*, in determining whether there is any likelihood of confusion can be summarised as follows:

(i) by comparison of the conflicting marks;

(ii) by considering the goods/services to which the conflicting marks are to be applied; and

(iii) by considering the type of customers of the proprietors of the conflicting marks.

The underlying consideration would be all the circumstances surrounding the usage or proposed usage of the conflicting marks taken as a whole in determining whether there will be any likelihood of confusion.

[15] It must also be emphasised that the circumstances of use to be considered must be with reference to the time the defendant's mark was applied for registration, that is, on 26 February 2008 for Class 18. In *Walton International* case (*supra*), which involved an appeal against the Registrar's decision to dismiss an opposition against registration for the trade mark "GIORDANO", the Federal Court held at p. 346:

> At the outset we would like to state here that the relevant date upon which the court has to decide whether the appellant is entitled to register the "GIORDANO" trade mark in Class 9 is the appellant's application date on 25 July 1992

[16] In the present case, the finding of the Registrar in respect of s. 14 of the TMA 1976 is as follows:

> In view of the aforesaid, I have come to the conclusion that the Applicant's mark as a whole is neither identical nor similar to those of the Opponent's marks and that the use of the Applicant's mark is unlikely to cause confusion or deception to the public. I also find no evidence to indicate that the use of the Applicant's mark is contrary to law or that it contain any offensive matter. Thus, the opposition under Section 14 under the Trade Marks Act 1976 has failed.

[17] The plaintiff's first ground of objection is premised on s. 19(1) of the TMA 1976. Section 19(1) of the TMA 1976 reads as follows:

> (1) No trade mark shall be registered in respect of any goods or description of goods:
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> (a) that is identical with a trade mark belonging to a different proprietor and entered in the Register in respect of the same goods or description of goods or in respect of services that are closely related to those goods; or
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> (b) that so nearly resembles such a trade mark as is likely to deceive or cause confusion.

[18] Section 19(1) prohibits the registration of a trade mark that is either identical with a trade mark belonging to a different proprietor, or so nearly resembles it as is likely to deceive or cause confusion entered in the register in respect of the same goods or description of goods.

[19] Therefore, in this appeal, the registration of ROYAL POLO will not be allowed if:

(i) ROYAL POLO is identical with Polo or so nearly resembling Polo as is likely to deceive and cause confusion; and

(ii) that the plaintiff's goods are the same goods or the same description of goods as the respondent's goods.

[20] Having considered the plaintiff's registered mark Polo and the defendant's ROYAL POLO mark, I agree with the finding of the Registrar that there is no similarity between the two marks. Visually, conceptually or phonetically, the two (2) marks are clearly different:

Plaintiff's Mark		Defendant's Mark
Polo	vs.	ROYAL POLO

[21] Therefore, I agree with the finding of the Registrar that having compared as a whole of the defendant's mark against the plaintiff's registered mark, the defendant's mark is not similar and/or identical to the plaintiff's registered mark.

[22] Surely, the word "ROYAL" makes the defendant's marks totally different from the plaintiff's registered marks. Therefore, I am of the considered opinion that the use of the defendant's trade mark would not result in confusion and deception in a manner which would offend s. 19(1) of the TMA 1976.

[23] However, it is the submission of the plaintiff that premised on s. 14(1)(a) of the TMA 1976, the defendant's mark is also confusingly and deceptively similar to the plaintiff's family of trademarks, namely "Polo", "POLO", "Polo Haus", "Polo player device", "Horse device" and/or marks containing the word "Polo" and/or "POLO" with or without the "Polo player device" or "Horse device" ("the POLO marks"). Some of the said POLO marks are as follows:

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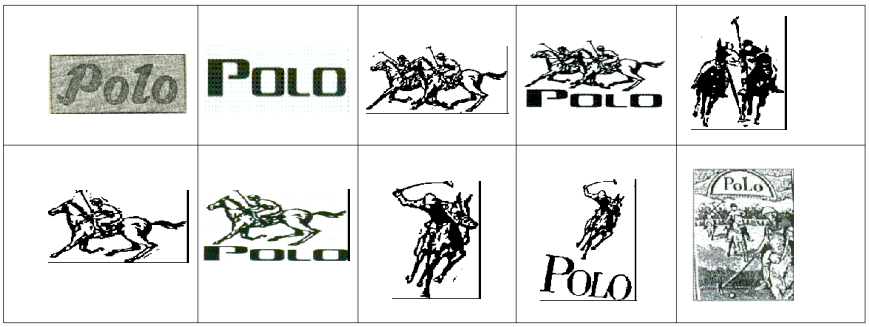

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[24] Section 14(1)(a) of the TMA 1976 provides as follows:

14. Prohibition on registration

(1) A mark or part of a mark shall not be registered as a trade mark -

(a) If the use of which is likely to deceive or cause confusion to the public or would be contrary to law;

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[25] The objective and purpose of s. 14(1)(a) is held by the Federal Court in *Walton International Ltd* (*supra*) as follows:

[25] The objective and purpose of s. 14(1)(a) of the Act is to protect the public and consumers from instances of confusion or deception as a result of the use of two similar marks. *Thus, under s. 14(1)(a) of the Act, a mark shall be refused registration if use thereof is likely to deceive or cause confusion to the public notwithstanding that it is the result of use of an earlier identical or similar mark, whether registered or not in Malaysia and which is being used in relation to good or services which may be different from that sought to be registered.*

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(emphasis added)

[26] The plaintiff submits that in the present case, the defendant's mark, ROYAL POLO is conceptually confusingly and/or deceptively similar to the plaintiff's word mark "polo". The plaintiff further submit that members of the trade and the public will probably be confused into believing that the goods distributed under the defendants's ROYAL POLO mark originated from or are associated with the plaintiff, when such was not the case.

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[27] The plaintiff also submit the word "polo" is central to the defendant's ROYAL POLO and that in all likelihood, the defendant's mark will be referred as a "polo mark", in the same manner as the plaintiff's family of "polo" marks. This will lead the public to assume that the defendant's ROYAL POLO is merely a new addition to or a variation of the plaintiff's family of "polo" marks.

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[28] However, I am also of the considered opinion that we cannot simply select the word "polo" in the defendant's trademark and compare it with the word "polo" in the plaintiff's mark, and completely ignore the word 'Royal'.

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The dangers of selecting component feature of a mark and comparing it with selective components of another mark was highlighted in the case of *Eriktico v. Erector* [1935] 52 RPC 136 where the court held:

> I do not think it is right to take a part of a word and compare it with a part of the other word; one word must be considered as a whole ... I think it is a dangerous method to divide the word up and seek to distinguish a portion of it from a portion of the other word.

[29] The same position was taken by Lord Russell in *Coca Cola of Canada v. Pepsi Cola of Canada* (1942) 59 RPC 127:

> Where you get a common denominator you must, in looking at competing formulae, pay more regard to the parts of the formulae which are not common - although it does not flow that must treat the words as though the common part was not there at all.

[30] Added to that, I am also of the considered opinion that the plaintiff has not complied with the basic principles of comparisons of marks. The plaintiff has effectively dissected the word "Royal" from the defendant's ROYAL POLO mark in order to make the comparison. The plaintiff did not apply the *Pianotist* test as adopted in *Tohtonku*'s case that when comparing marks, that the marks must be viewed as a whole.

[31] Further, in the case *Harrods Application* (1935) 52 RPC 65, it was held that if the element of the mark, the word 'polo' is common, then the potential consumers will not pay much attention to this common element, as the customers will be looking at the other feature, the uncommon element ('Royal'). At p. 70 of the judgment, the court held that:

> Now, it is a well recognised principle that has to be taken into account in considering the possibility of confusion arising between two trademarks, that, *where those two marks contain a common element which is also contained in a number of other marks in use in the market, such a common occurrence in the market tends to cause purchasers to pay more attention to the other features of the respective marks and to distinguish between them by those other features.*
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> (emphasis added)

[32] Therefore, even if there was a common element in the word 'polo', premised on *Harrods* case, the use of the words 'Royal' by the defendant on its mark will not cause any likelihood of confusion. And the Registrar also made the same finding when he held that:

> In **cases where there is a common denominator, it is important to look at the difference between the marks as well in order to determine** whether the challenged mark is sufficiently different from the earlier mark. It must be remembered that just because a registered mark is wholly included in a challenged mark, it does mean that it would necessarily cause confusion between the two. Instead, marks must be compared in its entirety and all relevant factors have to be considered in deciding whether confusion is likely to occur.

> **It can be seen that the Applicant's mark consists the mark "ROYAL" with the word "POLO" in a stylised and unique manner.** The presence of all these elements in the Applicant's mark has to be taken into consideration as this is how a mark is viewed by the consumers or public. **Comparing the Applicant's mark with those of the Opponent, it is clear that the Applicant's mark is dissimilar and can be distinguished from the opponent's marks**
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> (emphasis added)

[33] The same position was taken in several cases involving the Polo marks dispute. The first case is the United Kingdom decision of *10 Royal Berkshire Polo Club Trade Mark* (2001) RPC 643. This case involved a dispute between the mark '10 Royal Berkshire Polo Club' filed in Class 3 and the "POLO" family marks registered (5 earlier POLO registered marks were cited) by Polo Lauren Company in the same Class 3 for the same and similar goods. It was held that there is no likelihood of confusion between the two (2) marks despite the fact that both marks are for the same or similar Class 3 goods and both have the same word 'POLO' in them. It was held that:

> ... mere association which the public might make between two trademarks as a result of their analogous semantic content is NOT in itself a sufficient ground for concluding that there is a likelihood of confusion even if the earlier mark has a particularly distinctive character (either *per se* or because of the reputation it enjoys in the market place)
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> ...
>
> ... I am satisfied that the use of the word POLO as part of the applicant's mark does not capture the distinctiveness of the opponents earlier trademarks. **I do not think that people exposed to the use of the applicant's mark would notice that it contained the word POLO without also noticing that it contained the words ROYAL BERKSHIRE and CLUB.**
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> (emphasis added)

[34] Even if we accept the plaintiff's contention that its family marks already have a reputation in the market (as the "POLO" family marks registered by Polo Lauren Company in *10 Royal Berkshire Polo Club Trade Mark*), the same is not a sufficient ground to conclude that there is a likelihood of confusion as the customers would also notice the words "Royal".

[35] The other Polo case is a decision of the Singapore Court of Appeal in *The Polo/Lauren Co LP v. Shop In Department Stores Pte Ltd* [2006] 2 SLR 690. In this case, the court held that there is no likelihood of confusion between the registered "POLO" marks and the defendant's "POLO PACIFIC" mark. The court held as follows:

> 24. Bearing in mind that 'polo' is a common English word, we are unable to see how it could be said that the sign "POLO PACIFIC" with its special font and design is similar to the mark "POLO", except in the broadest sense that one word is common ...

In any event, for the purpose of determining similarity ... one must look at the mark and sign as a whole ... and bearing in mind the actual differences between the two, we cannot see how it can be said that the trial judge was wrong when he held that the sign and the mark are not similar ...

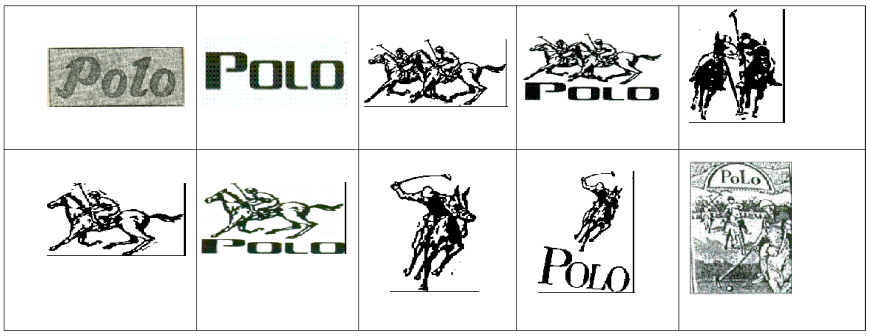
Indeed, in the light of our finding above that the sign and the mark are not similar, the question of confusion does not arise ...

(emphasis added)

[36] From Thailand, in the case of *Young Sangyo Co Ltd v. Department of Intellectual Property* (November 25, 2013) (reported in World Trademark Review Daily), the plaintiff applied to register their mark . The application for registration was rejected on the grounds that it was identical or similar to the registered marks of others, including . The plaintiff's suit to challenge the Registrar's order was dismissed by the IP and IT Court. The plaintiff's appeal was allowed by the Supreme Court which held that due to its appearance and pronunciation, the plaintiff's trademark "Beverly Hills Polo Club" was clearly different from the registered trademark "Santa Barbara Polo & Racquet Club" as well as the other cited trademarks. The court also considered that although both makes have the word 'polo', this does not preclude the plaintiff from using that word as part of the trademark, given its overall appearance and pronunciation was not confusingly similar.

[37] In *Polo/Lauren Co LP v. United States Polo Association* [2002] 1 SLR 326, the court finds that the pictorial device of the opponent and the applicant's use of the letter "USPA" as part of their composite marks were sufficient to distinguish the applicant's sign from the opponent's registered marks.

[38] Therefore, since the plaintiff's family of marks:



is different from the defendant's ROYAL POLO mark, the Registrar is correct to dismiss the plaintiff's opposition to the registration of the defendant's marks. As such, the plaintiff's appeal premised on s. 14(1)(a) of the TMA 1976 must fail.

[39] The plaintiff also submits that the defendant is not entitled to rely on other polo related marks on the register to support its contention that the word polo is common. The plaintiff submits that it is settled law that it is not permissible to draw any inference as to the use of trade marks by merely relying on the presence of the marks on the register. Reliance is placed on the following cases:

(i) *Willesden Varnish Company Ld v. Young & Marten Ld* (1922) 39 RPC 285 at p. 289 where Sargant J said:

> The fact that the mark is on the Register is not evidence that the mark has been used.

(ii) *Corn Products Refining Co v. Shangrila Food Products Ltd* AIR 1960 SC 142 where the Indian Supreme Court applied *Willesden Varnish* (*supra*). AK Sarkar J said at pp. 146 to 147:

> 15. The series of marks containing the common element or elements therefore only assist the applicant when these marks are in extensive use in the market. The onus of proving such user is of course on the applicant, who wants to rely on those marks. Now in the present case the applicant, the respondent before us, led no evidence as to the user of marks with the common element. *What had happened was that the Deputy Registrar looked into his register and found there a large number of marks which had either 'Gluco' or 'Vita' as prefix or suffix in it. Now of course the presence of a mark in the register does not prove its user at all. It is possible that the mark may have been registered but not used. It is not permissible to draw any inference as to their user from the presence of the marks on the register.* If any authority on this question is considered necessary, reference may be made to *Kerly* p. 507 & *Willesden Varnish Co Ltd v. Young & Marten Ltd*, (1922) 39 RPC 285 at 289.
>
> (emphasis added)

[40] I am of the considered opinion that the fact of the existence of many other polo related marks on the Register is merely to show how common the polo marks are in this country. Therefore, when the polo related mark is very common, the plaintiff simply cannot seek to claim monopoly over the said mark and attempt to wipe out others from using the polo related marks.

[41] In the case of *Club Europe Trade Mark* (2000) RPC 329, the case involves an application to register the Club Europe Holidays Ltd. Objection was raised by the British Airway's registered mark, "Club World". Vice Chancellor Sir Richard Scott held at p. 342:

> First, British Airways cannot claim a monopoly in the word "club" ... the word "Club" was generic, laudatory and non-distinctive, its association with a particular geographic word such as "world" may enable the combination to be regarded as distinctive but cannot in my judgment entitle British Airways to a monopoly of every other combination of Club

> and a geographical word ... if British Airways is right … would in effect be obtaining by the back door a monopoly over the word "Club" ... I do not think it can be said that "Club Europe" as a mark has resemblance so near "Club World" as to likely to deceive or cause confusion. The difference between "Europe" as a word and "World" as a word is obvious to everyone … In my judgment the registration of .. Club Europe is not barred ... by the prior registration of British Airways Club World mark.

[42] Therefore, to allow the plaintiff's appeal would effectively gives the plaintiff a monopoly over the generic and non-distinctive word 'polo'.

[43] In *The Polo/Lauren Co* (*supra*), the court held that:

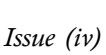
> 30. Furthermore, the word 'POLO' is commonly used in everyday language either as a reference to the sport or to a particular style T-shirts. It is settled that the courts are wary of allowing companies to monopolise words that are either purely descriptive or used in everyday parlance.

[44] In *McCain International Ltd v. Country Fair Foods Limited And Another* (1981) 5 RPC 69, the dispute before the Court of Appeal is the dispute between "McCain Over Chips" and "Birds Ete Over Chips". The plaintiff claimed that the use of the common words "over chips" by the defendant will likely create confusion and deception. The Court of Appeal rejected the plaintiff's claim and held that:

> ... **but they (plaintiff) take the risk of choosing descriptive words, then they run the risk that the defendants cannot be prevented from using those same descriptive words** so long as they make it clear that their brands of products are not the same as the brands of the plaintiff.
>
> (emphasis added)

[45] Similarly, in the case of *Helena Rubinstein Ltd's Appln* (1960) ROC 229, the dispute was between "Skin Dew" and "Skin Deep". The court held that there was no likelihood of confusion because the consumers will have the capacity for differentiating the two (2) marks since "Skin" is a commonly used word and there are such uses in the market. At p. 230 the court held that:

> ... the contemporaneous use upon like goods of a number of 'Skin' marks such as 'Skin Fare' and 'Skin Up' as well as a number of descriptions such as 'skin food', 'skin cleanse', 'skin tonic', 'skin lotion', 'skin balm' and 'skin freshener'. These sufficiently establish the existence of a consumer capacity for differentiating ...

[46] Therefore, since the word 'polo' is descriptive and is commonly used in the market, there is clearly no likelihood of confusion between the defendant's  mark and the plaintiff's "polo" marks.

Issue (iv)

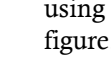
[47] Section 25 of the TMA 1976 provides that "Any person claiming to be the proprietor of a trade mark used or proposed to be used by him may make application to the Registrar for the registration of that mark in the Register in the prescribed manner".

[48] Kerly's Law of Trade Marks and Trade Names, 13th edn touched on s. 17(1) of the English Trade Marks Act 1938 (corresponding to section 25(1) of the TMA 1976 and observed that:

> ... claiming that he is entitled to be registered as the proprietor ... [the] claim must in some sense be a justified one ... *Provided however that the claim of proprietorship is made in good faith and is not rebuttable on the ground that in fact someone else was the proprietor, it is difficult to see how it can be objected to.* (emphasis added)

[49] In his finding, the Registrar said this:

> Having said that, the Applicant is entitled to be the proprietor of the Applicant's mark in respect of the said goods in the said class 18 in Malaysia as the Applicant has a same trademark Registered in Class 18 bearing Application Number 05015637. The opposition under Section 25 of the Trade Marks Act 1976 has failed.

[50] I am of the considered opinion that the *bona fide* of the defendant in filing the defendant's trade mark cannot be doubted as the defendant has been using the  mark since at least 2003, as can be seen from the sales figure.

[51] The plaintiff relied on the case of *In the Matter of the Trade Marks Act, 1983 and in the matter of Vitamin's Ld' Application* [1956] RPC 1 where the application for registration was refused on the ground that the applicant had sought to register a mark with the knowledge that someone else had originated a similar mark.

[52] However, in *Vitamin's Ld' Application* (*supra*), the subject matter is an identical trade mark, "*Pabalate*". In our present case, the defendant's mark is totally different to the plaintiff's 'polo' marks.

[53] The plaintiff also relied on the decision of the Court of Appeal in *Walton International Ltd v. Yong Teng Hin; Pendaftar Cap Dagangan, Malaysia (Interested Party)* [2010] 8 CLJ 802 where the court said at p. 813:

> [27] A person cannot be properly registered unless he is the proprietor of the mark. (see: *Re Hicks Trade Mark* [1897] 22 VLR 636). A proprietor is a person who at the moment he makes application to be registered to the exclusive use of the name or the mark, whether he then or before publicly adopted it. A man cannot be said to have adopted a name or a mark if someone else has done so before him.

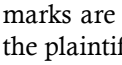
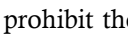
[54] In the above case, *Walton International Limited*, CA (*supra*), the trade mark in question is an identical mark, the "GIORDANO" trade mark. In the present case, the defendant cannot be said to be adopting the plaintiff's trade mark, as they are totally different mark. The defendant is seeking to register its own trade mark , which is different from the plaintiff's trade mark.

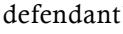
Issue (v)

[55] Parties are on common ground on the statement that the reputation and goodwill of a trader is extremely important given that it is the goodwill of a trader that will retain its customer base and attract or draw prospective customers to purchase the goods offered.

[56] In *The Commissioner of Inland Revenue v. Muller & Co's Margarine Ltd* [1901] AC 217, it was held by Lord Macnaghten at p. 223 that 'Goodwill' may be defined as the "benefit and advantage of the good name, reputation and connection with a business, whether it is a business that provides services or manufactures and/or distributes certain products. In other words, goodwill is the attractive force that brings in custom".

[57] The plaintiff submits that it has built its name and reputation in Malaysia from the date of first use of the Polo marks in 1981. Therefore, the Registrar should have given due regard to the fact that the plaintiff has obtained extensive reputation and goodwill its business under the POLO marks as that is exactly what sets the plaintiff apart from other traders in the market. It is also the underlying reason behind the confusion that would be caused by the use and registration of the defendant's mark, as members of the trade and the public who have become so accustomed with the goods bearing the polo marks originate from the plaintiff. As such, members of the trade and the public would be confused or deceived into believing that the goods distributed under the defendant's mark originate from the plaintiff or are associated with the plaintiff.

[58] However, I am of the considered opinion that since the plaintiff's marks are different from the defendant's  mark, then the issue of the plaintiff's goodwill and reputation in its business relating to the "POLO" marks is not relevant. This is because even if the plaintiff, as the proprietor of the "POLO" mark, has substantial goodwill and reputation, that does not prohibit the defendant from registering the defendant's  mark, as it is different from the plaintiff's Polo mark.

[59] The two marks are clearly distinguishable that members of the trade and the public would not assume or be deceived that the goods bearing the defendant's  mark could in any way be associated with the plaintiff's marks.

Issue (vi)

[60] The plaintiff submits that the defendant's mark is not distinctive of the defendant's products because the defendant's mark is confusingly similar to the plaintiff's POLO marks. In view of my findings that the defendant's mark is not confusingly similar to the plaintiff's POLO marks, the plaintiff's contention is simply untenable.

Issue (vii)

[61] The plaintiff submits that the use of the defendant's mark in relation to the defendant's goods is calculated to deceive or cause confusion and will lead the goods distributed under the defendant's mark being passed off as, being mistaken for or associated with, the goods of the plaintiff. However, since I find that the defendant's mark is not confusingly similar to the plaintiff's POLO marks; the issue of passing off is not relevant.

[62] In any event, I am also of the considered opinion that the Registrar has no jurisdiction on issues of passing off. Whether there is a case that would constitute passing off is for the court to decide, and the plaintiff ought to commence its case for passing off in the High Court. That is the purpose of s. 82(2) of the TMA 1976, which reads as follows:

> Notwithstanding subsection (1), nothing in this Act shall be deemed to affect the right of action against any person for passing off goods or services as those of another person or the remedies in respect thereof.

Conclusion

[63] The plaintiff relied on its family of POLO marks, but the only mark that is registered is the Polo mark. For this mark, the plaintiff had not adduced any evidence to show actual use since the date of registration in 1981, as the invoices merely refer to polo shirts and pants. There is no actual use in respect of goods in Class 18.

[64] The defendant is using its own mark 로얄실 고무. The defendant's mark is distinctive of the defendant. The defendant's mark is also visually and phonetically different from the plaintiff's POLO marks. As such, there can be no actual or likelihood of confusion or deception.

[65] In the premise, I find that there is no merit in the plaintiff's appeal and the same is dismissed with costs.